

REMARKS/ARGUMENTS

In the Office Action mailed May 15, 2007, claims 1-9, 11-22, 24-26, 28-43 and 45-55 were rejected under 35 U.S.C. §103 as being unpatentable over De La Huerga (US 2002/0084904 A1). Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga in view of Harilela (US 4,862,436).

The limitation requiring that “one of said coupling elements has a predetermined area, and wherein the other said coupling elements has a length greater than the length of said one coupling element” distinguishes the pending claims over the cited prior art. In rejecting claims 1-9, 11-22, 24-26, 28-43 and 45-55 as being anticipated by De La Huerga, the Office Action erroneously states that De La Huerga discloses that one of said coupling elements has a predetermined area and that the other said coupling elements has a length greater than the length of said one coupling element. There is no support in De La Huerga for the teachings alleged in the Office Action.

As in the prior Office Action, the rejection erroneously relies upon proportions of features in drawings which are not specifically discussed in the Specification. As cited in previous Responses to Office Actions, proportions of features in drawings are not evidence of actual proportions when the drawings are not to scale. Hockerson-Halberstadt, Inc. v. Avia Group Intel. 55 USPQ 2d 1487, 1491 (Fed. Cir. 2002) (“It is well established that patent drawings do not define the precise proportions of the elements and may not be relied upon to show particular sizes if the specification is completely silent on the issue”). The specification in De La Huerga does not mention the relative sizes of the capacitor plates. In fact the only mention of the size or shape of the capacitor plates is as follows: “In Fig. 34 plates 358 and 360 are shown in trapezoidal form only for illustrative purposes so that each can be easily distinguished from the other and it should be understood that plates of any shape that provide sufficient overlap may be employed.” From that statement it is clear that De La Huerga does not teach a particular size or shape and that relative size or shape is unimportant to De La Huerga. Further, De La Huerga does not even discuss the size of the

capacitor plates. Elements 106 and 108 in Fig. 2 are not even capacitor plates, they are merely ends of the bracelet. There is no capacitor structure recited in either 106 or 108 and no discussion of the relative size or shape of those ends.

In referring to the coupling elements the Office Action discusses several identified features of De La Huerga. Initially the Office Action refers to parts 106 and 108 in Fig. 2 as the coupling elements having a predetermined area. As described in the Specification for De La Huerga, parts 106 and 108 are not coupling elements or even electronic components, they are merely the ends of the bracelet. In addition, nothing in the Specification discusses the relative size or shape of the ends of the bracelet and reliance upon Fig. 2 for the relative size or shape or establishing a predetermined area thereof is legally incorrect.

The Office Action also refers to capacitive plates 358 and 360 as shown in Fig. 34 as having a predetermined area and disclosing that feature of the coupling elements as claimed in the present invention. Pursuant to the standards set out by the Federal Circuit in Hockerson-Halberstadt the appearance of elements 358 and 360 in Fig. 34 is not sufficient to “define the precise proportions of the elements and may not be relied upon to show particular sizes if the Specification is completely silent on the issue.” Paragraphs 228 and 229 of the Specification in De La Huerga discuss Fig. 34 and plates 348 and 360 as shown therein. As previously cited, De La Huerga states that “in Fig. 34 plates 358 and 360 are shown in trapezoidal form only for illustrative purposes so that each can be easily distinguished from [sic] the other.” The reliance on the appearance of those elements in Fig. 34 to establish a teaching of predetermined area is legally incorrect.

The Office Action also refers to element numbers 1317 and 1315 in Fig. 17 as teaching a predetermined area for coupling elements. As with the other part references there is nothing in the Specification of De La Huerga that mentions 1315 and 1317 having a predetermined area. The citation to paragraphs 161 and 162 which discuss parts 1317 and 1315 as depicted in Fig. 17 does not mention either element having a predetermined area. The reliance on the appearance of those elements in Fig. 17 is

inconsistent with the legal standard established by the Federal Circuit in Hockerson-Halberstadt.

Accordingly, nothing in De La Huerga teaches a pair of coupling plates wherein one of the coupling plates has a predetermined area. The only support for such teaching cited in the Office Action is the appearance of certain elements in figures. As established by the Federal Circuit, patent drawings do not define precise proportions of elements where the specification is silent on the issue.

The Office Action also relies upon plates 358 and 360 in Figs. 34 and 35 as overlapping and having a predetermined length. The citation to paragraphs 228 and 229 of the Specification in De La Huerga provide no support for this alleged teaching. Accordingly, De La Huerga does not teach the claim limitation wherein “the other of said coupling elements has a length greater than the length of said one coupling element.”

The Office Action also states that changes in size/shape are not patentably distinct from prior art devices. Citing MPEP §2144.04 IV. The Office Action then misapplies the standards of MPEP §2144.04 IV. Specifically that section and the cases cited therein deal with patent claims that merely scale up or down the size of the entirety of a prior claimed process or apparatus. The cases cited in the MPEP, In re Rose 105 USPQ 237 (CCPA 1955), In re Reinhart, 189 USPQ 143 (CCPA 1976), and Gardener v. TEC Systems, Inc., 220 USPQ 777 (Fed. Cir. 1984) deal with the scalability of an entire process or apparatus. These cases do not deal with the re-proportioning of discreet elements within an apparatus or process. The Court in Gardener v. TEC Systems decided a very narrow factual issue. The ruling in Gardener was not dependent merely upon the fact that the patentee was changing the size/shape of a prior art device but that the patentee’s change in size/shape of the prior art device “did not specify a device which performed and operated any differently from the prior art.” Gardener, 220 USPQ at 786.

The present claims do not merely scale up or scale down a prior art device but recite relative dimensions of two features within the claimed device. Assuming for the sake of argument that the prior art did specify a size/shape of coupling elements, a

claim directed to a different size or shape of similar elements would not fall within the prohibitions of MPEP §2144.04 IV and as described in the cases cited therein. The present claims are patentably distinct from the prior art because they do not represent a mere scaling up or scaling down of that which is claimed in the prior art. The current claims recite a specific structure that performs differently from the prior art devices.

Specifically, the limitation requiring one of said coupling elements to have a predetermined area and the other of said coupling elements to have a length greater than the length of said one coupling element creates a structure whereby the coupling elements are almost assuredly overlapping to ensure a secure electrical connection. This configuration of capacitor plates specifically creates a structure having a predetermined capacitance and a predetermined resonance frequency, both of which are critical to the readers with which an identification band of the present invention can communicate. If the capacitor plates have a different predetermined area or do not span the entire length of the other capacitor plate then the predetermined capacitance and predetermined resonance frequency will be different and will not be compatible with the readers with which the identification band is intended to be used. The prior art merely requires that the capacitive plates be of any shape to provide sufficient overlap. The limitations set forth in the current claims are not obvious over the cited prior art and MPEP §2144.04 IV fails to support the rejection.

For the reasons set forth above the combination of De La Huerga and Harilela fails to render claim 23 obvious. As set forth above, De La Huerga fails to teach the limitation requiring the relative sizes and shapes of the coupling elements. Harilela fails to supply this missing teaching as well.

By amendment applicant has introduced new claims 56-74 which add as an additional limitation the predetermined capacitance and predetermined resonance frequency established by the predetermined area and excess length of the mating capacitor plates. This amendment does not introduce new matter. Support exists in the Specification for these amendments beginning on page 12, line 7 and running through page 14, line 8.

Applicants submit that the claims as presented comprise allowable subject matter. Accordingly claims 1-9, 11-26, 28-43 and 45-74 are in condition for allowance, notice of which is respectfully requested.

Respectfully submitted,

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